

to the non-elected inventions. No new matter has been introduced by this Amendment.

The specification at page 3 has been revised to refer to the shuss ribbon as a “schuss” or lateral ribbon. Similarly, the specification at page 3 has been revised so that the term “franze” is also referred to as “franse” or “longitudinal ribbon.” The specification at page 7, lines 3-4 has been revised to more clearly describe how the average length A is determined. No new issues have been raised by this Amendment that require further consideration or search. Entry and reconsideration are respectfully considered.

USPTO INTERVIEW:

Applicants would like to thank the Examiners for the courtesy extended their representative during the interview conducted on January 19, 2000. The above Amendment and following remarks represent the substance of that interview. It is noted that express statements in the Examiner Interview Summary Record reflect that the Examiners consider the terms schuss/shuss/lateral/transverse to be equivalent. Similarly, the Examiners also consider the terms franze/franse/longitudinal to be equivalent. The specification has been amended in certain places to reflect the equivalency of terms permitted by the Examiners.

RESPONSE TO OBJECTION UNDER 35 USC § 132:

The Examiner has objected to the specification under 35 USC § 132. The Examiner as a result of the January 19, 2000 interview has withdrawn this objection. Accordingly, the objection to the “entire” Amendment A, set forth in the November 3, 1999 Office Action as constituting “New Matter” is improper and has been withdrawn.

RESPONSE TO OBJECTION UNDER 37 CFR § 1.75:

Claims 2-4 have been objected to as lacking antecedent basis in the original specification. Applicants have canceled claim 2 and rewritten claims 3 and 4 as new claims 10-11. Claims 10-11 respectively relate to netting where lateral ribbons of the modified schuss design are located on the outer edges (claim 10), or all the lateral ribbons are of the modified schuss design (claim 11).

The specification at page 3 has been amended to recite that,

The netting according to the present invention may have at least one modified shuss 18, may include modified shusses 18 located along the outside edges of the netting, or all of the shusses of the netting may be of the modified design. Each modified shuss may be formed from a plurality of ribbons.

The originally filed claims clearly support the phrase "at least one modified shuss" and the location of the shusses along the outer edges of the netting. See also Figure 2 where the modified shusses 18 are located at the outer edges. Accordingly it is respectfully submitted that claims 10 and 11 have proper antecedent support in the specification.

RESPONSE TO REJECTION UNDER 35 USC §112:

Claims 2-4 have been rejected under 35 U.S.C. §112 as being vague and indefinite. Claim 2 has been canceled and claims 3-4 have been rewritten as claims 10 and 11. It is respectfully submitted that claims 10 and 11 are definite and fully comply with the requirements of 35 USC § 112, second paragraph.

RESPONSE TO REJECTION UNDER 35 USC § 102

Claims 1 and 9 have been rejected under 35 U.S.C. §102 as anticipated by the Leiber '353 patent. Claims 2-4 have been rejected under 35 USC § 103(a) as being unpatentable over the Leiber '353 patent. Due to the common core of these rejections they will be treated together for the sake of brevity. Applicants respectfully traverse these rejections.

The Examiner maintains that although it was argued by the Examiner in the prior Office Action that the Leiber '353 patent "does not explicitly teach the claims modification percentage, it is reasonable to presume that the" Leiber '353 patent "invention would actually possess an actual longitudinal ribbon which is within the range claimed by the Applicant." The Examiner has also previously argued that "the burden is upon applicant to prove otherwise" (March 1999 Office Action). The Examiner has also argued that merely asserting that the claimed netting is made on a modified Raschel knitting machine is not adequate because the argument and scope of the claim are not commensurate. Applicants respectfully disagree.

Initially it is noted that applicants invention relates to the use of a modified schuss, i.e., a shuss or lateral ribbon having "an actual length that is more than 110% of the length of a calculated ribbon length." Thus, it is not understood why the Examiner states "longitudinal ribbon" which is separately recited and distinct from the modified shuss or lateral ribbon of the present invention.

Contrary to the Examiner's contentions, the Leiber '353 patent neither expressly nor inherently anticipates the claimed invention. Furthermore, the claimed invention is commensurate in scope with arguments of record.

THE CLAIMED INVENTION IS NOT INHERENT:

THE MPEP

M.P.E.P. § 2112, 7th Edition, pg. 2100-48 provides guidance to Examiners concerning rejections under 35 USC § 102, based upon inherency. According to the MPEP, “The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result....”, citing *In re Rijckaert*, 9 F.3d, 1531, 1534 (Fed. Cir. 1993), and that “the examiner must provide a basis “in fact and/or technical reasoning.” In the instant case, neither has been done.

The M.P.E.P. also states that “ONCE A REFERENCE TEACHING PRODUCT APPEARING TO BE SUBSTANTIALLY IDENTICAL IS MADE THE BASIS OF A REJECTION...THE BURDEN SHIFTS TO THE APPLICANT. However, in the instant case, although the Examiner has relied upon the Leiber ‘353 patent, the Examiner has completely ignored all the requirements that must be followed before the rejection is made.

APPLICABLE LAW:

There is no anticipation if any claimed element is absent from the reference. *See Kloster Speedsteel AB v. Crucible, Inc.*, 793 F.2d 1565, 1571 (Fed. Cir.), modified in part, 231 U.S.P.Q. 160 (Fed. Cir. 1986), cert. denied, 479 U.S. 1034 (1986). If a prior art reference does not expressly disclose all the elements of the claim, it may nonetheless constitute an anticipation if it inherently possesses all of the claimed elements that it does not expressly describe. *See Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 1570 (Fed. Cir. 1988) (“A claim is anticipated only if each and every element *as set forth in the claim* is found, either expressly or inherently

described, in a single prior art reference.") (Emphasis in original) (Citation omitted), *cert. denied*, 488 U.S. 892 (1988). Inherency, however, requires that the prior art necessarily produce what is claimed. *See In re King*, 801 F.2d 1324, 1326 (Fed. Cir. 1986); *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1554 (Fed. Cir. 1983) ("Anticipation of inventions set forth in product claims cannot be predicated on mere conjecture respecting the characteristics of products that might result from the practice of processes disclosed in references."). *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981); *Hansgirg v. Kemmer*, 102 F.2d 212, 214, 40 USPQ 665, 667 (CCPA 1939). (An inherent property has to flow naturally from what is taught in a reference.)

ANALYSIS:

The Examiner admits that the Leiber '353 patent fails to expressly teach or suggest the claimed "modified shuss", i.e., "a shuss or lateral ribbon having "an actual length that is more than 110% of the length of a calculated ribbon length" or a "calculated shuss length." (March 1999 Office Action, p. 6). In addition, applicants' patent application expressly teaches that the netting produced in the Leiber '353 patent has "transverse shrinkage of the netting," which problem has been overcome by applicants' present invention of providing a modified shuss, i.e., a shuss having "an actual length that is more than 110% of the length of a calculated ribbon length." Thus, applicants' invention recognizes and solves a problem not solved by the prior art, which solution is expressly recited in the claims, i.e., a shuss "having "an actual length that is more than 110% of the length of a calculated ribbon length."

Despite the Leiber '353 patent being completely silent regarding the problem recognized

by applicants, and their solution, the Examiner relies on the doctrine of inherency. However, the Examiner's reliance upon the doctrine of inherency is factually and legally flawed. For the doctrine of inherency to apply: "the prior art [must] necessarily produce what is claimed (*In re King*, 801 F.2d at 1326); inherency "cannot be predicated on mere conjecture respecting the characteristics of products that might result from the practice of processes disclosed in references." *W.L. Gore & Assocs., Inc.*, 721 F.2d at 1554 ; or "has to flow naturally from what is taught in a reference" (*Hansgirg*, 102 F.2d at 214.

In the present case the Leiber '353 patent fails to teach or suggest the use of a corrugated trick plate for the knitting machine. It is the curved surfaces of the corrugated trick plate that produce the modified shuss having an "actual length that is more than 110% of the length of a calculated ribbon length," which is expressly recited in each and every claim. Consequently, the Examiner has not produced a scintilla of evidence that the trick plate disclosed in the Leiber '353 patent necessarily produces what is claimed in the instant application. The Examiner has also produced no logical explanation of how the claimed netting having the above noted property "flow from the teachings of the" Leiber '353 patent, especially in view of applicants express teachings, under oath or declaration that the Leiber '353 patent, and the conventional trick plate cannot produce the claimed netting. Consequently, the Examiner's rejection does not even follow the guideline set forth in the MPEP, and does exactly what the Court's holding in *W.L. Gore & Assocs., Inc. v. Garlock, Inc.* expressly forbid, relies on mere conjecture and does not provide any "fact and/or technical reasoning."

CLAIMS AND ARGUMENT ARE COMMENSURATE IN SCOPE:

The Examiner has also taken the position that applicants' arguments are not commensurate in scope with the claimed invention, e.g., the present claims do not positively recite the disclosed corrugated trick plate or include a positive process step for producing a netting which minimizes transverse shrinkage because a corrugated plate is used in a Raschel knitting machine. While applicants' claims do not expressly recite the corrugated plate or the process step, they do positively recite the result, i.e., length dimension, based on a relationship generated by "exemplary" physical elements, a particular trick plate, and methodology, using that plate in a knitting machine.

With respect to application claims 2-4, each claim, in addition to requiring the modified shuss, also specifies the location of the shuss, or that all of the shusses are of the "modified" type. Since the Leiber '353 patent does not teach or disclose applicants' trick plate, the Leiber patent certainly cannot teach or suggest the limitations of claims 10 and 11. As set forth above, Applicants' invention cannot be said to be either taught or suggested by Leiber '353 patent and is therefore believed to be allowable over the prior art. Accordingly it is respectfully submitted that the rejections under §§102/103 are improper and should be withdrawn.

CONCLUSION:

It is respectfully submitted that the claimed invention is not taught or suggested by the references of record considered by the Examiner, and therefore the application is in condition for allowance.

AUTHORIZATIONS:

37 C.F.R. § 1.116 Amendment
Ser. No. 08/978,235

Our Docket No. 1874-4014

AUTHORIZATIONS:

A Petition for Extension of Time for one month is concurrently filed herewith.

The Assistant Commissioner is hereby authorized to charge any additional fees which may be required for the timely consideration of this amendment under 37 C.F.R. §§ 1.16 and 1.17, including any extension of time, or credit any overpayment to Deposit Account No. 13-4500, Order No. 1874-4014.

Respectfully submitted,

MORGAN & FINNEGAN, L.L.P.

By:



Michael S. Marcus
Registration No. 31,727
(202) 857-7887 Telephone
(202) 857-7929 Facsimile

Dated: March 3, 2000

CORRESPONDENCE ADDRESS:

MORGAN & FINNEGAN, L.L.P.
345 Park Avenue
New York, New York 10154
(212) 758-4800 Facsimile
(212) 751-6849 Telecopier